

REMARKS

This application has been amended in a manner that is believed to place it in condition for allowance at the time of the next Official Action.

Claims 35-70 are pending in the present application. Claims 35-70 are directed to a process for coating cheeses and a coated cheese, wherein the polyol contains at least 5 carbon atoms (see page 5, lines 5-6). Claims 1-34 have been cancelled.

In the outstanding Official Action, the Official Action stated that the information referred to in the EP 0811664 A1 publication had not been considered. The Official Action stated that the Information Disclosure Statement filed on January 22, 2002 did not comply with 37 CFR 1.98(a)(3) because it did not include a concise explanation of the relevance of the publication.

However, pursuant to MPEP 609(A)(3), applicants provided an English-language version of the search report indicating the relevance of the publication with the Information Disclosure Statement. As a result, applicants believe that the publication should have been considered by the Patent Office. For the Examiner's convenience, applicants attach herewith a copy of the Information Disclosure Statement that was filed on January 22, 2002 with the present application. Applicants also attach herewith a copy of the postcard receipt evidencing receipt by the

Patent Office. Applicants respectfully request that the publication be considered at this time.

In the outstanding Official Action, claims 11, 27 and 28 were objected to for containing several informalities. However, applicants note that claims 1-34 have been cancelled. Applicants believe that claims 35-70 have been drafted in a manner so as to obviate these objections.

Claims 13, 14, 16, 27-29 were rejected under 35 USC 112, first paragraph, for allegedly failing to comply with the written description requirement. This rejection is respectfully traversed.

In imposing the rejection, the Official Action noted that claims 13 and 29 recited a C₃-C₁₆ dicarboxylic acid. The Official Action alleged that there was no support in the original disclosure for selecting a carbon number of 3 as an endpoint and that there was no support for why this endpoint was critically established. However, at this time, the Examiner is respectfully reminded that the original claims are considered to be part of the original disclosure.

Moreover, applicants note that whether the subject matter set forth in the disclosure is "critically established" is not the standard for determining whether the disclosure satisfies the requirements of 35 USC 112, first paragraph.

Rather, the standard is whether the disclosure indicates that the applicants were in "possession" of the subject

matter at the time the application was filed. As the recitation to a C₃-C₁₆ dicarboxylic acid was present in the original claims, applicants believe that the disclosure shows that applicants were in possession of the subject matter at the time the application was filed. Nevertheless, applicants understand that the specification itself might not necessarily provide antecedent basis for the recitation set forth in the claims. As a result, applicants have amended the specification at page 8 to indicate that a C₃-C₁₆ dicarboxylic acid is within the scope of the present invention. As the recitation was present in the original claims, no new matter has been added to the present disclosure.

The outstanding Official Action also rejected claim 27 on the grounds that the claim recites a fatty acid group A in an amount of 50-75% by weight and a fatty acid group B present in an amount of 50-100% by weight. The Official Action alleged that there was no support in the original disclosure for selecting the weight percents and that there was no support for why these percents were critically established.

However, as noted above, this is not the standards for determining whether a disclosure satisfies the written description requirement. As the weight percents were present in the original claims, applicants believe that the present disclosure satisfies the written description requirement.

The specification has also been amended to provide antecedent basis for these recitations. As the recitations

directed to the weight percents of the fatty acids were present in the original claims, no new matter has been added to the present disclosure.

In the outstanding Official Action, claims 1-17, 21, 23, 27, 28, 29, 30, 31 and 32 were rejected under 35 USC 112, second paragraph, for allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Applicants believe the present amendment obviates this rejection. As noted above, claims 1-34 have been cancelled. Applicants believe that the new claims have been drafted in a manner so as to address the rejections under 35 USC 112, second paragraph. As a result, applicants believe the present amendment obviates this rejection.

Claims 1, 6, 7, 8, 9, 11, 15, 18, 23, 24, 25, 27, 30, 31, 32, 33 and 34 were rejected under 35 USC 102(b) as allegedly being anticipated by MIKKELSEN et al. Applicants believe that the present amendment obviates this rejection. As noted above, the claimed invention is directed to a method for coating cheese and a coating composition comprising an esterification product of a polyol having a branched chain with at least 5 carbon atoms.

MIKKELSEN et al. disclose compositions for coating cheeses, which include glycerides of fatty acid and acetic acid (column 3, line 55 to column 4, line 1). In other words, MIKKELSEN et al. teach esters of a polyol having 3 carbon atoms. Indeed, these glycerides are actually compounds as described on

page 3 of the present application (see present specification, lines 8-22), which do not provide the mechanical resistance and organoleptic properties according to the present invention.

As a result, applicants believe that MIKKELSEN et al. fail to anticipate the claimed invention.

Claims 13, 14, 16, 17 and 29 were rejected under 35 USC 103(a) as allegedly being unpatentable over MIKKELSEN et al. in view of SEABORNE et al. Applicants believe the present amendment obviates this rejection.

As noted above, applicants believe that MIKKELSEN et al. fail to disclose or suggest the claimed invention. In an effort to remedy the deficiencies of MIKKELSEN et al., the Official Action cites to SEABORNE et al. However, SEABORNE et al. disclose glyceride-based coating compositions for cheeses. SEABORNE et al. disclose edible film coatings including a shellac based on glycerides modified with poly acids. As a result, applicants believe that SEABORNE et al. fail to remedy the deficiencies of MIKKELSEN et al. Indeed, SEABORNE et al. fail to disclose or suggest a coating composition comprising an esterification product of a polyol having a branched chain with at least 5 carbon atoms.

Thus, in view of the above, applicants believe that proposed combination fails to render obvious the claimed invention.

In the outstanding Official Action, claims 1, 2, 3, 4, 5, 6, 7, 9, 10, 11, 12, 18, 19, 20, 21, 22, 23, 25, 26, 27, 28 and 32 were rejected under 35 USC 103(a) as allegedly being unpatentable over VOLPENHEIM in view of the Handbook of Thermoset Plastics and KESTER. Applicants believe the present amendment obviates this rejection.

VOLPENHEIM discloses fatty acid esters of polyols, in particular esters of sorbitol or sucrose which respectfully comprise 6 and 12 carbon atoms. However, VOLPENHEIM fails to disclose or suggest branched esters.

While the disclosed esters are described as useful in the "food industry", a specific use for the coating compositions is not suggested. Indeed, the esters are generally designed as low-calorie food components (column 1, lines 12-30).

The Handbook of Thermoset Plastics is cited to show the use of neopentyl glycol and polyester compositions.

KESTER describes polyesters similar to those of VOLPENHEIM, which are used in a coating suitable for inhibiting moisture transmission. In particular, KESTER teaches that the coating can be used to inhibit the transmission of moisture into or out of food products.

However, none of the publications disclose or suggest a coating or a process for coating cheese with a coating composition comprising esters of branched polyols as set forth in the claimed composition. Indeed, compositions for coating cheese

are not described. Moreover, the compositions disclosed by the publications are intended to coat dry products such as cereal, starch-based snack food, nuts or biscuits.

Thus, in view of the above, applicants believe that the proposed combination fails to render obvious the claimed invention.

Indeed, at this time, the Examiner is respectfully reminded that in imposing the rejection, applicants believe that the Patent Office uses an improper analysis for determining obviousness. The Examiner is respectfully reminded that to establish a *prima facie* case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the publications themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a publication. Second, there must be a reasonable expectation of success. Third, the publications must teach or suggest all the claim recitations.

The teaching or suggestion to make the claimed invention and the reasonable expectation of success must be found in the publications, and not based on applicant's disclosure. *In re Vaeck*, 947 F2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See also MPEP §2143-2143.03. Upon reviewing the outstanding Official Action, it is believed that the Official Action fails to satisfy these criteria.

In view of the above, it appears that none of the cited publications disclose the possible use of an ester of a polyol with a branched chain having at least 5 carbon atoms for coating a cheese product.

Indeed, the publications that relate to cheese coatings systematically make use of glycerides compounds, i.e. esters of polyol with a linear chain having 3 carbon atoms. In particular, the Examiner's attention is respectfully directed to U.S. Patent No. 5,516,536, U.S. Patent No. 4,810,534, and U.S. Patent No. 4,585,658. Thus, the use of esters other than glycerides for coating cheese is not disclosed or suggested by the cited publications.

As a result, applicants believe that one of ordinary skill in the art would lack the motivation and a reasonable expectation of success from using esters other than glycerides in coating cheeses.

The Examiner is also respectfully reminded that a critical step in analyzing obviousness pursuant to 35 U.S.C. §103(a) is casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, only guided by the publications and then-accepted wisdom in the field. Close adherence to this methodology is important in cases where the invention itself may prompt an Examiner to "fall victim to the insidious effect of a hindsight syndrome, wherein that which only the invention taught is used against its teacher." Indeed,

to establish a prima facie case of obviousness, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *In re Kotzab*, 217 F.3d 1365, 1369-70, 55 USPQ 2d 1313, 1362 (Fed. Circ. 2000). The fact that the prior art could be so modified would not have made the modification itself obvious unless the cited publications themselves suggested the desirability of the modification. *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Circ. 1984). Thus, as the above-identified publications fail to provide the necessary motivation to combine and modify the publications in a manner so as to obtain the claimed invention, applicants believe that the cited publications, alone or in combination with each other, fail to disclose or suggest the claimed invention.

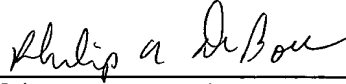
Applicants believe that the present application is in condition for allowance at the time of the next Official Action, with claims 35-70, as presented. Allowance and passage to issue on that basis is respectfully requested.

The Commissioner hereby is authorized in this, concurrent, and future replies, to charge payment or credit any

overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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Appendix:

The Appendix includes the following items:

- copy of Information Disclosure Statement filed January 22, 2002 and postcard receipt evidencing such filing